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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,217	10/28/2003	Ludomir A. Budzyn	B-1	4967
7590 Ludomir A. Budzyn 7 Edgewood Place Maplewood, NJ 07040			EXAMINER WASSUM, LUKE S	
			ART UNIT	PAPER NUMBER
			2167	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/14/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/695,217	BUDZYN, LUDOMIR A.	
	Examiner	Art Unit	
	Luke S. Wassum	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 23 January 2007 has been entered.

The Invention

2. The claimed invention is a method for investigating intellectual property related to a reference piece of intellectual property. In one embodiment, the user inputs a trademark, and the system generates a list of patents and patent applications which are related in some way to said trademark.

Priority

3. The Applicant's claim to domestic priority under 35 U.S.C. § 119(e) based upon U.S. Provisional Patent Application 60/421,710, filed 28 October 2002, is acknowledged.

Drawings

4. The application includes informal (hand drawn) drawings. While these drawings are acceptable for examination purposes, the examiner encourages the Applicant to submit formal drawings at the earliest opportunity. Early submission of formal drawings will help expedite post-allowance processing and publication of the issued patent.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Frank et al. (U.S. Patent Application Publication 2006/0224412).

7. Regarding claim 1, **Frank et al.** teaches a method for investigating intellectual property related to a user inputted reference piece of intellectual property (see disclosure that a user can perform a search for particular products based upon various criteria, including associated trademark-related IP data records, paragraph [0311]; see also drawing Figures 78-80) as claimed, said method comprising:

- a) providing a first database of discrete pieces of first intellectual property, said pieces of first intellectual property each including an associated set of first characteristics (see disclosure that the system includes multiple databases including various embodiments of intellectual property, such as patents, trademarks, copyrights and trade secrets, among others, paragraphs [0053] and [0232] et seq.);
- b) providing a second database of discrete pieces of second intellectual property, said second intellectual property being of a different type from said first intellectual property (see disclosure that the system includes multiple databases including various embodiments of intellectual property, such as patents, trademarks, copyrights and trade secrets, among others, paragraphs [0053] and [0232] et seq.);
- c) searching said first database to identify said pieces of first intellectual property having predetermined characteristics in common with the reference piece

of intellectual property (see drawing Figure 81, illustrating the submission of a search request for product information, the predetermined characteristics being the selected product; see also disclosure that upon selection of a product, the first [trademark] database is queried to display any trademarks associated with the selected product, paragraph [0314] and drawing Figures 82 and 83);

- d) developing without user input at least one query based on at least a portion of said first characteristics of said identified pieces of first intellectual property (see disclosure that upon selection of a product, the second [patent] database is queried to display any patents associated with the selected product, the claimed first characteristics being the selected product, paragraph [0314] and drawing Figures 82 and 83);
- e) searching without user input said second database to identify said pieces of second intellectual property satisfying said at least one query (see disclosure that upon selection of a product, the second [patent] database is queried to display any patents associated with the selected product, the claimed first characteristics being the selected product, paragraph [0314] and drawing Figures 82 and 83); and

f) transmitting information related to said identified pieces of second intellectual property to the user (see drawing Figures 82 and 83, illustrating the display of information related to said identified pieces of second [patent] intellectual property to the user).

8. Regarding claim 2, **Frank et al.** additionally teaches a method for investigating intellectual property wherein said pieces of first intellectual property are selected from the group consisting of registered trademarks, unregistered trademarks and applications to register trademarks (see disclosure that the system includes multiple databases including various embodiments of intellectual property, such as patents, trademarks, copyrights and trade secrets, among others, paragraphs [0053] and [0232] et seq.).

9. Regarding claims 3 and 5, **Frank et al.** additionally teaches a method for investigating intellectual property wherein said pieces of second intellectual property are selected from the group consisting of patents and patent applications (see disclosure that the system includes multiple databases including various embodiments of

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intellectual property, such as patents, trademarks, copyrights and trade secrets, among others, paragraphs [0053] and [0232] et seq.).

10. Regarding claims 4 and 6, **Frank et al.** additionally teaches a method for investigating intellectual property wherein the reference piece of intellectual property is a trademark (see disclosure that the system includes multiple databases including various embodiments of intellectual property, such as patents, trademarks, copyrights and trade secrets, among others, paragraphs [0053] and [0232] et seq.).

11. Regarding claim 7, **Frank et al.** additionally teaches a method for investigating intellectual property wherein said step of searching said first database includes searching said first database to identify said pieces of first intellectual property which are identical matches to the reference piece of intellectual property (see disclosure that a user can perform a search for particular products based upon various criteria, including associated trademark-related IP data records, paragraph [0311]; see also drawing Figures 78-80; see also drawing Figure 81, illustrating the submission of a search request for product information; see also disclosure that upon selection of a product, the first [trademark] database is queried to display any trademarks associated with the selected product, paragraph [0314] and drawing Figures 82 and 83; note that since the product is

associated with the reference piece of intellectual property [trademark], the search of the first [trademark] database will retrieve the trademark identical to the reference piece of intellectual property [trademark]).

12. Regarding claim 8, **Frank et al.** additionally teaches a method for investigating intellectual property wherein said step of searching said first database includes searching said first database to identify said pieces of first intellectual property which include at least one search term in common with at least a portion of the reference piece of intellectual property (see disclosure that a user can perform a search for particular products based upon various criteria, including associated trademark-related IP data records, paragraph [0311]; see also drawing Figures 78-80; see also drawing Figure 81, illustrating the submission of a search request for product information; see also disclosure that upon selection of a product, the first [trademark] database is queried to display any trademarks associated with the selected product, paragraph [0314] and drawing Figures 82 and 83; note that the search term in common would be the product associated with all of the retrieved pieces of intellectual property).

13. Regarding claim 9, **Frank et al.** additionally teaches a method for investigating intellectual property further comprising sorting said identified pieces of first intellectual

property (see disclosure of the capability of sorting of IP data, paragraphs [0284]-[0287]).

14. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. Patent 6,694,331).

15. Regarding claim 1, Lee teaches a method for investigating intellectual property related to a user inputted reference piece of intellectual property as claimed, said method comprising:

- a) providing a first database of discrete pieces of first intellectual property, said pieces of first intellectual property each including an associated set of first characteristics (see disclosure that the system supports the analysis of different types of intellectual property information, such as patents, trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10, lines 34-40; see also col. 11, line 63 through col. 12, line 7);
- b) providing a second database of discrete pieces of second intellectual property, said second intellectual property being of a different type from said first intellectual property (see disclosure that the system supports the analysis of

different types of intellectual property information, such as patents, trademarks, copyrights, trade secrets, etc., col. 1, lines 16-22; see also col. 10, lines 34-40; see also col. 11, line 63 through col. 12, line 7);

c) searching said first database to identify said pieces of first intellectual property having predetermined characteristics in common with the reference piece of intellectual property (see disclosure of the identification of a 'source grouping' of intellectual property information, col. 8, lines 17-28; see also designation of a 'source grouping', col. 10, lines 34-45);

d) developing without user input at least one query based on at least a portion of said first characteristics of said identified pieces of first intellectual property (see disclosure of the use of a source grouping to generate a list of 'different elements' found in the source grouping, col. 8, line 56 through col. 9, line 15; see also col. 10, line 61 through col. 11, line 39; see also col. 11, line 63 through col. 12, line 29);

e) searching without user input said second database to identify said pieces of second intellectual property satisfying said at least one query (see disclosure that the created 'field of search' can be used as a search query to be executed by a local or remote database, col. 12, lines 26-29; see also disclosure that the invention can be used to variously search and/or

analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42); and

- f) transmitting information related to said identified pieces of second intellectual property to the user (see disclosure that other modules may be included that, among other things, output the results achieved through operation of the search server, col. 2, lines 7-11).

16. Regarding claim 2, Lee additionally teaches a method for investigating intellectual property wherein said pieces of first intellectual property are selected from the group consisting of registered trademarks, unregistered trademarks and applications to register trademarks (see disclosure that the invention can be used to variously search and/or analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

17. Regarding claims 3 and 5, Lee additionally teaches a method for investigating intellectual property wherein said pieces of second intellectual property are selected from the group consisting of patents and patent applications (see disclosure that the invention can be used to variously search and/or analyze information related to any form of intellectual property, including patents and trademarks, col. 12, lines 30-42).

18. Regarding claims 4 and 6, Lee additionally teaches a method for investigating intellectual property wherein the reference piece of intellectual property is a trademark (see disclosure of the receipt of input data or signals from the user identifying select intellectual property to form a 'source grouping' of intellectual property information, col. 8, lines 17-28; see also the fact that the intellectual property information can include trademarks, col. 8, lines 11-17).

19. Regarding claim 7, Lee additionally teaches a method for investigating intellectual property wherein said step of searching said first database includes searching said first database to identify said pieces of first intellectual property which are identical matches to the reference piece of intellectual property (see disclosure that the select intellectual property information input by the user may be individual intellectual property identified by native indicia, which would include identifying trademarks which identically matched an input native indicia, col. 8, lines 30-34).

20. Regarding claim 8, Lee additionally teaches a method for investigating intellectual property wherein said step of searching said first database includes searching said first database to identify said pieces of first intellectual property which

include at least one search term in common with at least a portion of the reference piece of intellectual property (see disclosure that the select intellectual property information input by the user may be individual intellectual property identified by native indicia, which would include identifying trademarks which have, for instance, a common assignee, col. 8, lines 30-34).

21. Regarding claim 9, Lee additionally teaches a method for investigating intellectual property further comprising sorting said identified pieces of first intellectual property (see disclosure of the sorting of search results, col. 4, lines 49-57 et seq.).

22. Regarding claim 10, Lee additionally teaches a method for investigating intellectual property wherein said step of sorting includes comparing each of said identified pieces of first intellectual property with the reference piece of intellectual property to determine degree of similarity therebetween (see disclosure of the sorting of search results based upon relevancy or weighted relevancy, col. 4, lines 49-57 et seq.).

23. Regarding claim 11, Lee additionally teaches a method for investigating intellectual property wherein said steps of developing at least one query and searching said second database are sequentially conducted for each identified piece of first

intellectual property (see disclosure that each piece of intellectual property in the source grouping is reviewed in order to ascertain different elements to be used as search criteria, col. 8, lines 56-63; see also col. 10, line 61 through col. 11, line 2; see also col. 11, line 63 through col. 12, line 7; also note that for at least the cases where none or exactly one piece of first intellectual property is identified, the execution of said developing step and searching step is de facto sequential).

24. Regarding claim 12, Lee additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes the name of the owner of the associated said piece of first intellectual property, and wherein said at least one query includes a first query, said first query being to identify all pieces of second intellectual property in which the owner of the respective said identified piece of first intellectual property has rights (see disclosure that the search engine performs searches based on input data such as Inventor and Assignee, col. 4, lines 15-29).

25. Regarding claim 13, Lee additionally teaches a method for investigating intellectual property wherein said first query being to identify all pieces of second intellectual property in which the owner of the respective said identified piece of intellectual property has recorder ownership rights (see disclosure that the search

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engine performs searches based on input data such as Inventor and Assignee, col. 4, lines 15-29).

26. Regarding claim 14, Lee additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes the goods or services of the associated said piece of first intellectual property, and wherein said at least one query includes a second query, said second query being to identify all said pieces of second intellectual property which relate to the goods or services of the respective said identified piece of first intellectual property (see disclosure that the intellectual property can be searched based on classification, including the classification of goods and services for trademarks, col. 6, lines 35-56).

27. Regarding claim 15, Lee additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes information relating to dates of first use of the associated said piece of first intellectual property, and wherein said at least one query includes a third query, said third query being to identify all said pieces of second intellectual property having a filing date or priority date after the dates of first use of the respective said identified piece of first intellectual property

(see disclosure that the search engine performs searches based on input data such as Publication Date, Filing Date, Related Data and Priority Data, col. 4, lines 15-29).

28. Regarding claim 16, Lee additionally teaches a method for investigating intellectual property wherein one of said first characteristics includes a classification of the associated said piece of first intellectual property, and wherein said at least one query includes a fourth query, said fourth query being to identify all said pieces of second intellectual property having a classification equivalent to the classification of the respective said identified piece of first intellectual property (see disclosure that the search engine performs searches based on input data such as International Classification, U.S. Classification, and Cross-Reference Classification, col. 4, lines 15-29).

Response to Arguments

29. Applicant's arguments filed 23 January 2007 have been fully considered but they are not persuasive.

30. Regarding the Applicant's argument that the Lee reference fails to disclose the claimed feature of developing and executing *without user interaction* a query based upon

at least a portion of said first characteristics of said identified pieces of intellectual property, the examiner respectfully disagrees.

The examiner points out that it is a well settled rule that a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. See *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979) and *In re Lamberti*, 545 F.2d 747, 192 USPQ 278 (CCPA 1976) as well as *In re Bode*, 550 F.2d 656, 193 USPQ 12 (CCPA 1977) which indicates such fair suggestions to unpreferred embodiments must be considered even if they were not illustrated. Additionally, it is an equally well settled rule that what a reference can be said to fairly suggest relates to the concepts fairly contained therein, and is not limited by the specific structure chosen to illustrate such concepts. See *In re Bascom*, 230 F.2d 612, 109 USPQ 98 (CCPA 1956).

In this case, the Lee reference teaches the use of a field-of-search module whereby the results of a previous search can be used to "automatically (or manually) create, add or suggest such search information (e.g., classes and subclasses) for a field-of-search." See col. 11, lines 37-39.

In this case, the resulting 'field-of-search' constitutes the claimed 'query'. Clearly, this disclosure anticipates *at least* the claimed development of a query without user interaction.

Furthermore, at col. 12, lines 19-29, the following is disclosed:

20 creation of a field-of-search (step 708). Where desired, the search information may be statistically analyzed for use in automatically generating, adding, or suggesting a field-of-search. As illustrated in FIG. 5, for example, search information that has a frequency of appearance in the selected source grouping that is greater than a predetermined frequency value may be automatically added to the field-of-search created (step 709). As used in a search system, as one example, the field-of-search thus created can form (or be part of) a search query or criteria to be executed by a local or remote database.

It is disclosed that the search information is statistically analyzed, and any search information that has a frequency of appearance greater than a predetermined frequency may be automatically added to the field-of-search created. Once again, this disclosure anticipates *at least* the claimed development of a query without user interaction.

However, this disclosure also anticipates the claimed *execution* of a query without user interaction.

The disclosure differentiates between automatically generating, adding, or suggesting a field-of-search. Clearly, 'suggesting' a field-of-search would require user interaction to confirm or modify the suggestion. However, the reference also discloses, separately from suggesting a field-of-search, generating or adding a field-of-search. Since this is differentiated from the disclosed 'suggesting' a field-of-search, there is a clear suggestion that the 'generated' or 'added' field-of-search is not presented to the user to await some user action.

Furthermore, it is also disclosed that "...the field-of-search thus created can form (or be part of) a search query or criteria to be executed by a local or remote database." This disclosure also clearly suggests that the field-of-search is automatically generated *and thereafter executed* without user interaction.

The rejection is maintained.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Unger et al. (U.S. Patent 5,721,910) teaches a relational database system which can be used to determine the meaning of technical documents such as patents.

Winer et al. (U.S. Patent 6,665,670) teaches a method for determining the likely uniqueness and novelty of a subject concept, such as a patent.

Frank et al. (U.S. Patent 7,127,405) teaches a method for selecting and protecting intellectual property assets.

Lee (U.S. Patent Application Publication 2002/0138297) teaches an apparatus for analyzing intellectual property information.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Luke S. Wassum
Primary Examiner
Art Unit 2167

lsw
13 March 2007